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10/623,134

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Richard L. Sandor

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WINSTON & STRAWN LLP

PATENT DEPARTMENT

1700 K STREET, N.W.

WASHINGTON, DC 20006

EXAMINER

VETTER, DANIEL

ART UNIT

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3628

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/623,134

Applicant(s)

SANDOR, RICHARD L.

Examiner

DANIEL P. VETTER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 21, 23, 24 and 37-39 is/are pending in the application.
4a) Of the above claim(s) 21, 23, 24, 38 and 39 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-12 and 37 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. Claims 1-12, 21, 23-24, and 37-38 were previously pending in this application. Claims 1 and 37 were amended and new claim 39 was added in the reply filed January 9, 2008. Claims 1-12, 21, 23-24, and 37-39 are currently pending in this application.

Response to Arguments

2. Applicant's amendment overcomes the objection made to claim 37 as a duplicate of claim 1 and it is withdrawn.

3. Applicant's arguments filed January 9, 2008 have been fully considered but they are not persuasive. Applicant argues that the cited references do not teach the newly added limitation of "wherein the emission allowance and offset holding information is based on an emission reduction schedule established for the participant." Examiner respectfully disagrees and maintains that Soestbergen is sufficient to teach this limitation. The broadly recited "emission reduction schedule established for the participant" reads upon the determined emission reduction goals set for a given time period disclosed in Soestbergen (§ 0108-09, "establish[ing] relative GHG responsibilities"), as the claimed embodiment does not limit who establishes the emission reduction schedule. Applicant also argues that in Soestbergen "companies are not issued emission allowances based on the values in the appreciation table" (Remarks, page 6). However, the companies that follow the table are issued reduction credits after their compliance record is evaluated (§ 0111). Accordingly, examiner maintains the rejections.

Election/Restrictions

4. Newly added claim 39 does not comply with the original restriction requirement. This claim is a copy of a distinct invention previously set forth in canceled claim 13 that went non-elected in the response to the original restriction requirement. Accordingly, this claim is withdrawn from consideration.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 5-6, and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Soestbergen, et al., U.S. Pat. Pub. No. 2002/0143693 (Reference A13 of the IDS submitted Jan. 5, 2006).

7. As per claim 1, Soestbergen teaches an emissions reduction trading system comprising: a registry that stores emission allowance and offset holding information for participants in a greenhouse gas emissions market (§§ 0014), wherein the emission allowance and offset holding information is based on an emission reduction schedule established for the participant (§§ 108-09); and a trading platform communicatively coupled to the registry (§§ 0013-14), the trading platform being configured to enable trades of emission allowances and offsets by participants (§ 0014).

8. As per claim 5, Soestbergen teaches the system of claim 1 as described above. Soestbergen further teaches the greenhouse gas emissions market comprises multi-sector and multi-national components (§§ 0007-08).

9. As per claim 6, Soestbergen teaches the system of claim 1 as described above. Soestbergen further teaches participants register projects that are issued offsets (§ 0071) amounting to at least a minimum level of mitigated tons of CO.sub.2 per year (§§ 0070, 0108).

10. As per claim 9, Soestbergen teaches the system of claim 1 as described above. Soestbergen further teaches the emission allowance and offset holding information stored by the registry includes baseline information (§ 0106).

11. As per claim 10, Soestbergen teaches the system of claim 9 as described above. Soestbergen further teaches the registry further includes reduction schedule, and mitigation quantity information (§ 0108).
12. As per claim 11, Soestbergen teaches the system of claim 1 as described above. Soestbergen further teaches the trading platform manages a standardized greenhouse gas emissions trading program among a number of business sectors (§ 0196).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soestbergen, et al. in view of Sharp, et al., U.S. Pat. Pub. No. 2002/0111892 (Reference A of the PTO-892 part of paper no. 20070611).
15. As per claim 2, Soestbergen teaches the system of claim 1 as described above. Soestbergen does not teach a guarantee mechanism that ensures next-day payment for exchange-cleared trades transacted using the trading platform despite failure of buyer to execute payment. Sharp teaches a guarantee mechanism that ensures payment for exchange-cleared trades transacted using the trading platform despite failure of buyer to execute payment (§ 0141). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Sharp into the system taught by Soestbergen to facilitate an automated payment mechanism in an auction-based marketplace (as taught by Sharp; §§ 0141-42). Sharp further teaches the payment occurs on the second day and on thirty days after the trade is completed (§ 0085) but does not explicitly teach the payment occurs on the next day. However, it would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the payment is next-day payment because where

the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Furthermore, Applicant has not demonstrated the criticalities of the next-day time period rather than another time period such as those taught by Sharp (¶¶ 0085).

16. As per claim 37, Soestbergen teaches an emissions reduction trading system comprising: a registry that stores emission allowance and offset holding information for participants in a greenhouse gas emissions market (¶¶ 0014), wherein the emission allowance and offset holding information is based on an emission reduction schedule established for the participant (¶¶ 108-09); and a trading platform communicatively coupled to the registry (¶¶ 0013-14), the trading platform being configured to enable trades of emission allowances and offsets by participants (¶¶ 0014). Soestbergen does not teach a guarantee mechanism that ensures payment for exchange-cleared trades transacted using the trading platform; which is taught by Sharp (¶¶ 0141). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Sharp into the system taught by Soestbergen to facilitate an automated payment mechanism in an auction-based marketplace (as taught by Sharp; ¶¶ 0141-42).

17. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soestbergen, et al. in view of *Acid Rain Program: Allowance Auction and Electronic Allowance Transfer*, June 6, 1996, Federal Register, Vol. 61 No. 110, pages 28995-98 (Reference U of the PTO-892 part of paper no. 20070611; hereinafter "EPA Notice").

18. As per claim 3, Soestbergen teaches the system of claim 1 as described above. Soestbergen does not explicitly teach the trading platform can perform auctions of exchange allowances and/or offsets. EPA Notice teaches the trading platform can perform auctions of exchange allowances and/or offsets (page 1). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of EPA Notice into the system taught by Soestbergen

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because auctions are a known means used by organizations such as the Environmental Protection Agency ("EPA") to distribute allowances (as taught by EPA Notice; page 1).

19. As per claim 4, Soestbergen in view of EPA Notice teaches the system of claim 3 as described above. EPA Notice further teaches the auctions comprise single-clearing price auctions or discriminating price auctions (page 1). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of EPA Notice into the system taught by Soestbergen in view of EPA Notice because these are both types of auctions that are used by organizations such as the EPA to distribute allowances (as taught by EPA Notice; page 1).

20. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Soestbergen, et al. in view of Raines, et al., U.S. Pat. Pub. No. 2003/0229572 (Reference A16 of the IDS submitted Jan. 5, 2006).

21. As per claim 7, Soestbergen teaches the system of claim 6 as described above. Soestbergen does not teach participants not having projects with offsets amounting to at least the minimum level of offset issuance per year are aggregated into groups having collective projects with collective offsets totaling at least the minimum level of issued tons of CO.sub.2 per year. Raines teaches participants not having projects with offsets amounting to at least the minimum level of offset issuance per year are aggregated into groups having collective projects with collective offsets (§ 0045) totaling at least the minimum level of issued tons of CO.sub.2 per year (§ 0320). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Raines into the system taught by Soestbergen because many small residential reductions are in quantities too small to be marketable (as taught by Raines; § 0014).

22. Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soestbergen, et al. in view of Tuck, et al., U.S. Pat. No. 6,115,698 (Reference A8 of the IDS submitted Jan. 5, 2006).

23. As per claim 8, Soestbergen teaches the system of claim 1 as described above. Soestbergen further teaches the trading platform communicates with the registry to confirm identities of participants buying and selling trades (§ 0088). Soestbergen does not teach while providing anonymous trading to the participants. Tuck teaches while providing anonymous trading to the participants (column 2, line 14). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Tuck into the system taught by Soestbergen because anonymous trading is required of a true market (as taught by Tuck; column 2, lines 14-15).

24. As per claim 12, Soestbergen teaches the system of claim 1 as described above. Soestbergen further teaches the trades of emission allowances and offsets by participants are done (§ 0014). Soestbergen does not teach the trades are done in real-time. Tuck teaches the trades are done in real-time (column 2, lines 7-8). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Tuck to allow participants to consummate the best opportunities (as taught by Tuck; column 2, lines 8-9).

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL P. VETTER whose telephone number is (571)270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W Hayes/
Supervisory Patent Examiner, Art Unit 3628